

REMARKS

Claims 8 to 16 are now pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph one (1) of the Final Office Action, claims 8 to 16 were rejected under 35 U.S.C. §102(b) as anticipated by Klatt, U.S. Patent No. 4,510,906.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

In contrast to the subject matter of each of independent claims 8 and 16, the “Klatt” reference does not identically disclose (nor suggest) the feature, in which “the optimal operating point” is “a function of an output variable to be generated by the drive unit.” The “Klatt” reference merely refers to the dependence of the optimal operating point on current operating variables of the drive unit in the form of the engine speed and the engine temperature—as well as the engine characteristic (the type of engine used). But it does not identically disclose (nor even suggest) the dependence of the optimal operating point on an output variable to be generated by the drive unit, as provided for in the context of the claimed subject matter—that is, a setpoint, or optimal value.

Such an output variable to be generated by the drive unit, for example a setpoint torque, is not taken into consideration in the subject matter of the “Klatt” reference for determining the optimal operating point of the drive unit. While claims are interpreted in light of the specification and limitations from the specification are not read into the claims,” the Applicant does not ask that limitations be read into the claim. Rather, a setpoint torque, by way of example, is one example embodiment of the “an output variable to be generated.” In contrast, the “Klatt” reference does not disclose nor teach any “output variable to be generated.”

In this manner, the subject matter of claims 8 and 16 provides the advantage that an optimal operating point of the drive unit may be set even for an output variable to be generated. In contrast, the “Klatt” reference in no way ensures that at the operating point of the highest engine efficiency, at which the pressure point on the accelerator pedal is reached, a specified setpoint for an output variable of the drive unit can also be reached. The subject matter of the “Klatt” reference apparently concerns an optimal acceleration of the vehicle with respect to fuel consumption (col. 2, lines 50 to 57; and col. 1, lines 13 to 22). The behavior of the internal combustion engine in the subject matter of the “Klatt” reference is therefore not efficiency-optimal for every output variable to be generated by the drive unit. This is evidenced when the driver overrides the pressure point of the accelerator pedal to initiate a safe passing operation (col. 2, lines 62 to 68). In this operating state, the optimal efficiency set in accordance with the “Klatt” reference cannot account for the further variable of an output variable to be generated. That is, in such a passing operation, the subject matter of the “Klatt” reference offers no operating point having an optimal efficiency which accounts for the output variable of the drive unit to be generated.

In contrast, with claims 8 and 16, if the optimal operating point is made a function of the output variable to be generated by the drive unit, then it is possible to signal to the driver an optimal operating point in every operating state of the drive unit and to consume even less fuel in this manner.

Accordingly, the “Klatt” reference does not identically disclose or suggest the features discussed above, so that claims 8 and 16 are plainly allowable for the foregoing reasons.

Claims 9 to 15 depend from claim 8 and are therefore allowable for the same reasons as claim 8.

As further regards dependent claim 11, the Final Office Action asserts that “the output variable includes a setpoint torque ([3, 1-15] shift gears; [2, 32-45] the engine).” It is

U.S. Pat. App. Ser. No. 10/523,346
Attorney Docket No. 10191/4088
Reply to Final Office Action of September 24, 2007

respectfully submitted that the text at column 2 (lines 32 to 45) refers only to the current engine speed, the current engine temperature and the engine characteristic. That is, the type of engine used. The text at column 3 (lines 1 to 15) concerns a driver who is able to receive a gear shift recommendation via the gas pedal, where control 9 moves wedge 3 slightly back (to the left) as soon as a suitable rotational frequency is reached and the load conditions permit a shift. The driver thus detects that an upshift is expedient without being distracted from traffic. The same effect may also be achieved by a short impulse, that is, a back-and-forth movement of wedge 3.

Such a gear shift recommendation does not in any way disclose the claim 11 feature in which the optimum operating point is determined as a function of a *setpoint torque* as an output variable to be outputted by the drive unit. The gear shift recommendation is not the signaling of an optimum operating point of the drive unit as with claim 8 (and 16), but rather a signaling of how a higher engine efficiency factor could possibly be achieved.

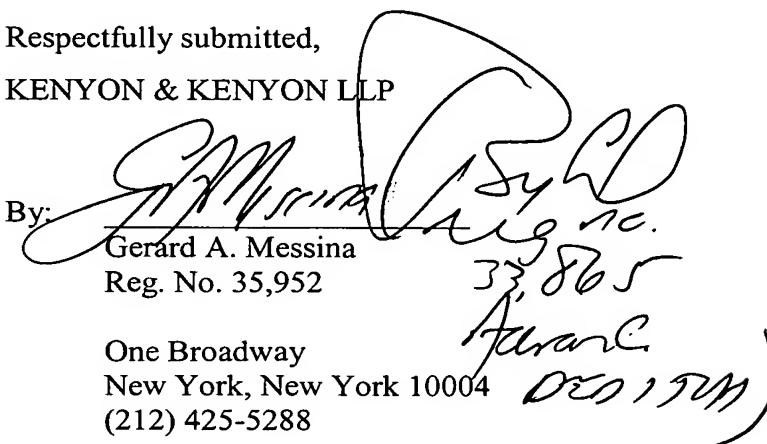
In summary, it is respectfully submitted that all of claims 8 to 16 are allowable for the foregoing reasons.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable and it is respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Date: 11/30/2007

Respectfully submitted,
KENYON & KENYON LLP

By: 
Gerard A. Messina
Reg. No. 35,952

One Broadway
New York, New York 10004
(212) 425-5288

CUSTOMER NO. 26646